

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Matti HAMALAINEN et al. Confirmation No.: 2104
Serial No.: 10/511,382 Group Art Unit: 1793
Filed: October 14, 2004 Examiner: Jie Yang
For: METHOD FOR THE RECOVERY OF GOLD

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**SUPPORTING ARGUMENTS
FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

In response to the Final Office Action mailed October 9, 2008, applicants concurrently file herewith a Notice of Appeal along with a Pre-Appeal Brief Request for Review ("Request").

Arguments begin on page 2 of this paper.

ARGUMENTS1. *Status of the Claims*

Claims 1-11 are pending in this application, of which claim 1 is the sole independent claim. Claims 1-11 stand rejected.

2. *Claim Rejections and Patentability of the Present Invention*

The October 9, 2008 Final Office Action rejects claims 1-2, 4-5, 7, and 9-11 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,487,819 ("Everett"), and rejects claims 3, 6, and 8 under 35 U.S.C. §103(a) as being obvious over Everett alone.

Claim 1 recites (emphasis added):

A method for the recovery of gold from a leaching residue or intermediate product containing iron and sulphur, which is generated in the chloride leaching of a copper sulphide raw material at atmospheric pressure, comprising *leaching the gold from the residue or intermediate product in an aqueous solution consisting essentially of copper (II) chloride, sodium chloride and oxygen-containing gas*; keeping the oxidation-reduction potential of the suspension formed at a value below 650 mV and the pH at a value of 1 - 3, whereby the iron and sulphur remain mainly undissolved; recovering the dissolved gold, and; discarding the undissolved residue as waste.

It is not disputed that Everett discloses a method for the recovery of gold that requires the presence of a halex compound in the aqueous leach solution. The impasse between applicants and the Examiner lies in the construction of the transitional phrase "consisting essentially of" as recited in claim 1. Applicants proffer a construction which excludes halex compounds from the aqueous solution used in the leaching step. The Examiner rebuts the applicants' proposed construction.

"Consisting essentially of" language "signals that the invention necessarily includes the listed ingredients and is open to unlisted ingredients that do not materially affect the basic and novel properties of the invention. *PPG Industries v. Guardian Industries Corp.*, 156 F.3d 1351,

1354 (Fed. Cir. 1998) (emphasis added). Applicants' argument, as set forth in the July 1, 2008 Amendment and Response, can be summarized as follows:

- 1) the instant specification is clear as to what is a basic and novel property of the aqueous leach solution (oxidation-reduction potential below 650 mV);
- 2) the instant specification clearly teaches that the presence of a halex compound in the aqueous leach solution materially affects this basic and novel characteristic (by increasing the oxidation-reduction potential); and
- 3) Everett requires the presence of a halex compound in the aqueous leach solution (see, e.g., col. 10, lines 20-23 of Everett).
- 4) Thus, applicants conclude that Everett cannot anticipate the method of claim 1, because Everett teaches a method that requires the presence of a halex compound in the aqueous leach solution, while claim 1 claims a method that specifically excludes a halex compound from the aqueous leach solution.

The October 9, 2008 Office Action, in rebuttal, construes the phrase "consisting essentially of" to include halex compounds, arguing that:

the oxidation-reduction potential, which is identified as a basic and novel characteristic of the instant invention, is a result-effective variable in term[s] of the gold leaching, which is evidenced by [Everett] . . . The applicant has not shown that the introduction of the additional halide has materially changed the basic and novel characteristic of the applicant's invention because the oxidation potential range (between +600 to +1000mV) of [Everett] overlaps the oxidation-reduction potential range at a value below 650 mV as recited in the instant claim 1 (pages 4-5 of the October 9, 2008 Office Action).

The only issue relevant to the construction of "consisting essentially of" as recited in claim 1 is whether the presence of a halex compound in the aqueous leach solution, as required by Everett, is excluded from the scope of the claim by virtue of the "consisting essentially of" language. Applicants respectfully submit that the answer to this question is completely independent of the disclosure of Everett. As set forth in the Manual of Patent Examining Procedure, "consisting essentially of" language "limits the scope of a claim to the specified materials or steps 'and those that do not materially affect the basic and novel characteristic(s)' of the claimed invention." MPEP § 2111.03 (citing *In re Herz*, 537 F.2d 549, 551-52 (CCPA

1976)). Applicants have clearly demonstrated that the presence of a halex compound in the aqueous leach solution, as required by Everett, does indeed materially affect a basic and novel characteristic of the aqueous leach solution, and is therefore excluded from the scope of the claim (July 1, 2008 Amendment and Response, summarized above).

The Examiner contends that the oxidation-reduction potential, identified by applicants as a basic and novel characteristic of the aqueous leach solution, is a result-effective variable in terms of the gold-leaching. Applicants respectfully submit that whether oxidation-reduction potential is a result-effective variable is not germane to the issue of construction of the "consisting essentially of" language recited in the leaching step of claim 1. The only relevant issue is whether the presence of a halex compound in the aqueous leach solution, required by Everett, materially affects the oxidation-reduction potential of the solution, and is thus excluded from the scope of claim 1.

The Examiner also contends that the oxidation-reduction potential range of Everett overlaps with the oxidation-reduction potential range recited in claim 1. Applicants respectfully submit that whether the oxidation-reduction potential range recited in claim 1 overlaps the range disclosed in Everett is not germane to the issue of construction of the "consisting essentially of" language recited in the leaching step of claim 1. Again, the only relevant issue is whether the presence of a halex compound in the aqueous leach solution, required by Everett, materially affects the oxidation-reduction potential of the solution, and is thus excluded from the scope of claim 1.

For the foregoing reasons, a method for the recovery of gold utilizing an aqueous leaching solution that requires the presence of a halex compound (as disclosed by Everett) is not encompassed by the method claimed in claim 1.

3. **Conclusion**

Accordingly, applicants respectfully submit that the method of claim 1 is not anticipated by and is thus patentably distinct from the method disclosed in Everett.

Applicants have not individually addressed rejection of dependent claims 2-11 because applicants submit that the independent claim from which they directly or indirectly depend is in condition for allowance as set forth above. Applicants, however, reserve the right to address such rejections of the dependent claims should such be necessary.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment for an extension of time to Deposit Account No. **13-4500**, Order No. 4819-4722.

Respectfully submitted,
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